

REMARKS

Upon entry of the present amendment claims 1-17 are pending in the application. Claims 1-2, 4-5, and 12-7 have been amended, and claims 18-20 have been added in accordance with the requirements of U.S. patent practice. Claims 3, and 10-11 have been cancelled; leaving claims 1-2, 4-9, and 12-20 for consideration upon entry of the present amendment.

Amendments to the claims and new claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

1. Claim Amendments and New Claims

Claim 1 has been amended to define the multicomponent system as “curable thermally or both thermally and with actinic radiation,” and to delete “water” as an alternative for component (III). Support for this amendment can be found at least on p. 1, ll. 13-15 and in Preparation Example 6 (The Preparation of Component (III)) and in Examples 1 and 2, p. 25, l. 6 to p. 29, l. 9.

Claim 5 has been amended to change (I) to (I'), and to delete “water” as an alternative for component (III). Support for this amendment can be found at least in Examples 1 and 2, p. 25, l. 6 to p. 29, l. 9.

Non-substantive changes have been made in claims 12-17 for clarity.

New claim 18 is a revision of claim 10 for clarity, with no substantive changes.

New claims 19 and 20 have been drafted to more specifically claim the invention. Claim 19 is the first step of the process recited in claims 5 and 20 and is believed to be independently patentable.

No new matter has been introduced by these amendments.

2. **Rejection of Claims 10-17 Under 35 U.S.C. § 101, and 35 U.S.C. § 112, Second Paragraph**

Claims 10-17 stand rejected under 35 U.S.C. § 101 because allegedly,

“the claimed recitation of a use, without setting forth any steps involved in the method/process, it is unclear which methods/processes the applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.”

Claims 10-17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite allegedly because it “merely recites a use without any active, positive steps delimiting how this use is actually practiced.”

Applicants greatly appreciate the detailed explanation of these rejections but must respectfully disagree, at least to the extent that the rejections apply to new claim 18 and amended claims 12-17 as now worded.

New claim 18 which replaces previously presented claim 10, recites the steps of “applying the multicomponent system of claim 1 to at least one substrate and curing the multicomponent system thermally, or both thermally and with actinic radiation, to provide a coating, an adhesive layer, or a seal.”

Claims 13-17 depend, either directly or indirectly, from new claim 18, and incorporate all the limitations of new claim 18. These claims therefore also recite the foregoing steps.

Claim 12 has been amended to depend from claim 5, instead of claim 11, which has been cancelled. Claim 5 recites three process steps.

Since claims 12-18 now recite process steps, reconsideration and removal of these rejections is respectfully requested.

3. **Rejection of claims 1-3, 5-7, and 10-17 under 35 U.S.C. §102(b) as being anticipated by Fiori et al., U.S. Patent No. 6,313,218, hereafter “Fiori”.**

Fiori generally discloses a process for making a low volatile organic content, isocyanate based, curable, oil-in-water emulsion comprising the steps of (i) mixing an isocyanate crosslinking

agent (a) with (b), wherein (b) is a water-in-oil emulsion comprising a water dispersible, surface active isocyanate reactive material (b1) and an aqueous medium (b2), and (ii) mixing the water-in-oil emulsion of step (i) with an aqueous medium to produce a curable oil-in-water emulsion having a VOC content of about 2.1 lbs/gal (252 g/L) or less (col. 3, ll. 17-44).

The PTO alleges that the subject claims are anticipated by Fiori. The PTO relies heavily on Example 1 of Fiori as the basis of the rejection.

Example 1 of '218 (column 11, lines 43-68 and column 12, lines 1-21) shows a multicomponent system comprising a water-in-oil dispersion. As to component (I) of claim 1, a water-in-oil emulsion (column 12, lines 10-20), containing water-dispersible polymeric binders (column 11, lines 50-56) with 98% 2-Heptanone (column 11, line 47) as the solvent is demonstrated. CYTHANE® 3174 (column 18, line 39) is the polyisocyanate, and contains at least two reactive isocyanate functional groups. With respect to component (II) of claim 1, the polyisocyanate was dissolved in butyl acetate (column 18, line 40), which is an essentially water-free liquid. Regarding component (III) of claim 1, the final product inherently contains water and polymeric binders after mixing (column 12, lines 13-20).

Applicants greatly appreciate the detailed basis of this rejection but must respectfully disagree. Fiori does not teach an element present in amended claim 1, i.e. that component III comprises binder (A) in dispersion and/or solution in water. To anticipate a claim, a single source must contain all of the elements of the claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

Fiori's Example 1 does not disclose a multicomponent system as alleged by the PTO. Example 1 may correspond to Applicants' component (I'), which is a water-soluble and/or water-dispersible, binder (A) having at least two isocyanate reactive groups, and in solution and/or

dispersion in at least one organic solvent and is water-free. However, Fiori's Example 1 does not correspond to Applicants' component (III) of claim 1. Component (III) is a dispersion or solution of a separate Binder (A) in water, not a water-in-oil emulsion of Binder (A).

The table below is provided to clearly compare the multicomponent systems of the Applicant and Fiori:

Lettmann Claim 1		Fiori (col. 3, ll. 17-44)	
I'	Binder (A) in at least one organic solvent, and water-free – Example 1	(b1)	Surface active isocyanate reactive material
I	Water-in-oil emulsion comprising binder (I')	(b)	Water-in-oil emulsion comprising surface active isocyanate reactive material (b1)
II	Polyisocyanate	(a)	Polyisocyanate
III	Binder A in dispersion and/or solution in water		Aqueous medium, but no additional binder

As can be seen from the table, Fiori does not teach an element present in amended claim 1, i.e. that component III comprises binder (A) in dispersion and/or solution in water.

The PTO alleges, “the process for preparing the multicomponent system, as outlined in claim 3, is demonstrated by Fiori in Example 1.” Applicants respectfully traverse, at least to the extent that this rejection is applicable to new claims 19 and 20, which are based on previously presented claim 3. With reference to the table above, Fiori does not teach that “the component (III) comprises at least one aqueous component comprising at least one binder (A) in dispersion and/or solution in water” as required by new claims 19 and 20. The example entitled “Production of Curable Emulsion A” in Fiori teaches instead adding “four portions of water (10.4 g total)” (col. 18, ll. 41-42), not adding at least one binder (A) in dispersion and/or solution in water. Therefore Fiori does not anticipate new claims 19 and 20.

The PTO alleges,

As to claim 5, *Fiori* anticipates the preparation of oil-in-water emulsions. The preparation of water-in-oil emulsions is outlined in Example 1 (column 11, lines 43-68 and column 12, lines 1-20). The addition of water to the water-in-oil emulsion of Example 1 is demonstrated in column 18, lines 41-49 to create an oil-in-water emulsion. *Fiori* teaches "...a key aspect to obtaining improved results is to first prepare a water-in-oil emulsion of the components, then add additional aqueous medium until phase inversion occurs. Additional aqueous medium can then be added to adjust the resulting oil-in-water emulsions to the desired solids content and viscosity as appropriate for a chosen end use," (column 9, lines 56-60). A detailed description of procedures for admixing water to create the oil-in-water emulsion (column 9, lines 64-68 and column 10, lines 1-38) is given. Curing is anticipated at ambient or elevated temperatures (column 11, lines 29-36).

Applicants respectfully traverse, at least to the extent that this rejection is applicable to new claim 5 as herein amended. The PTO cites the use by *Fiori* of water, or aqueous medium, in order to create an oil-in-water emulsion. *Fiori* is silent on the use of "at least one aqueous component comprising at least one polymeric binder (A) in dispersion and/or solution in water" as required by amended claim 5. Therefore *Fiori* does not anticipate amended claim 5.

Independent claim 10 has been redrafted as independent claim 18. Independent claim 18 incorporates the inventive element of the composition of claim 1. As stated above, *Fiori* does not anticipate claim 1 because *Fiori* does not teach an element present in amended claim 1, i.e. that component III comprises binder (A) in dispersion and/or solution in water. Therefore, claim 18 is not anticipated by *Fiori*.

Dependent claims 9 and 11-17 also stand rejected as being anticipated by *Fiori*. Claims 9 and 12 depend from, and incorporate all the limitations of claim 5, and claims 13-17 depend from, and incorporate all the limitations of claim 18, either directly or indirectly. As discussed above,

Fiori does not anticipate independent claims 5 and 18. Therefore dependent claims 9, and 11-17 are not anticipated by Fiori, either.

For all of the above reasons, it is respectfully submitted that claims 1-3, 5-7, and 12-18 are not anticipated by Fiori. Therefore, reconsideration and removal of the anticipation rejection of these claims is respectfully requested.

4. Rejection of claims 4, 8, and 9 under 35 U.S.C. §103(a) as obvious over Fiori

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

Applicants respectfully submit that the present claims are patentable over Fiori under 35 U.S.C. §103(a), at least because Fiori does not teach or suggest every element of independent claims 5 and 20, from which claims 4, 8, and 9 depend.

Claim 4 depends from, and incorporates all the limitations of new claim 20. Claims 8 and 9 depend from, and incorporate all the limitations of amended claim 5. As discussed in the preceding section, Fiori does not teach or suggest an element present in claims 5 and 20, i.e. that component III comprises binder (A) in dispersion and/or solution in water.

For this reason, Applicants respectfully assert that a prima facie case of obviousness has not been established, and that the present claims are patentable over Fiori. Therefore, reconsideration and removal of the obviousness rejection of dependent claims 4, 8 and 9 is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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